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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 09/810,920 | 03/16/2001 | Steven P. Bitler | 12969-1 | 7133 |

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| EXAMINER | |
|---|---|
| SZEKELY, PETER A | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 1714 | |

DATE MAILED: 06/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 09/810,920 | BITLER ET AL. | |
| | Examiner | Art Unit | |
| | Peter Szekely | 1714 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *13 December 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-7,9-20 and 22-66* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-7,9-20 and 22-66* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

## DETAILED ACTION

### *Priority*

1. The examiner does not consider petitions. Applicants should resubmit it to the Petition Branch.

2. The Final Rejection imposed on 10/10/03 is withdrawn in light of the granting of the petition filed 12/12/03, by the Director of Technology Center 1700.

### *Claim Objections*

3. Claim 66 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The intended use does not further limit the claimed composition of claim 1.

### *Double Patenting*

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-7, 9-20 and 22-66 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 40-75 of copending Application No. 09/398,377. Although the conflicting claims are not identical, they are not patentably distinct from each other because they cover the same subject matter, featuring identical ingredients and overlapping concentrations. The intended use, e.g. cosmetic composition has no patentable significance.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-5, 9-12, 20, 37-38 and 62-63 are rejected under 35 U.S.C. 102(b) as being anticipated by Mueller et al. 5,281,329.

8. Mueller et al. disclose petroleum oils and polyalkyl (meth)acrylates in column 1, lines 9-13, side chain crystalline polymers from column 2, line 15, to column 3, line 30. Cooling occurs when the heating is removed. The polymer is used as a pour point depressant, which is not a thinner. It is analogous to an anti-freeze, that is, it stops the oils from solidifying. Cosmetic composition is the intended use and as such it has no patentable significance. Furthermore, crude oil encompasses the ingredients yielded by fractionating it, for example mineral oil, which is a basic ingredient of many cosmetic

formulations. The concentration of the side chain crystalline polymers in the oil is 1-10,000 ppm, which overlaps the 0.1-12% range shown in applicants' specification, on page 10, lines 14-18. The disclosures of a reference are not limited to its Illustrative Examples. All properties are inherent in the composition. There is no Declaration by Dr. Bitler in the file. Applicants' claims are not novel. Claims 5 and 6 were mistakenly rejected in previous actions.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

10. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

11. Claims 1-5, 9-12, 20, 37-38, 59-60 and 62-63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mueller et al., in view McCoy et al. 3,894,958 or

Paboucek 5,217,636, further in view of Franck et al. 3,915,843 and even further in view of Norbury et al. 4,976,961.

12. Mueller et al. has been discussed already. McCoy et al. teach polymethacrylate copolymer thickeners thickening mineral oil, the methacrylate copolymer containing n-dodecyl alcohol in an amount of 50-55% and octadecyl alcohol in an amount of 20-22%. See column 6, lines 37-52. Paboucek recites mineral oils thickened with polyalkyl methacrylates, which solves the cold temperature problems. See column 2, lines 55-59. Franck et al. display oil being mixed with polymethacrylate polymer, which both improves the viscosity characteristics versus temperature and thickens the oil. See column 1, lines 30-37. Norbury et al. reveal encapsulated cosmetic materials comprising encapsulated oil thickened with polyacrylics, see claims 1-2, where the oil can be mineral oil, castor oil, jojoba oil or vegetable oil (claim 12). It would have been obvious to one having ordinary skill in the art, at the time the invention was made, to use the side chain crystallized polymers of Mueller et al. to thicken mineral oil, which is a petroleum oil, since their effectiveness in mineral oil is shown by McCoy et al. and Paboucek, which mineral oil thickened with polyacrylics is the basis of the cosmetic formulation of Norbury et al. Both of the Franck et al. and Paboucek references prove that pour point depression and thickening are not mutually exclusive and the phenomenon of thickening while keeping the oil liquid is well known. It is not necessary for a prior art reference to disclose the same property or utility as the claimed product to establish a prime facie case of obviousness under 35 U.S.C. paragraph 103.

13. Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Peter Szekely whose telephone number is (571) 272-1124. The examiner can normally be reached on 7:00 a.m.-5:30 p.m. Tuesday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Peter Szekely
Primary Examiner
Art Unit 1714

P.S.
5/27/04